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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,305	12/23/2003	Toshihiko Ina	64903-023	5559

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MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,305

Applicant(s)

INA ET AL.

Examiner

Mark J. Beauchaine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Application Publication Number US 2004/0153408 A1 by Jones et al ("Jones") in view of Patent Number US 7,222,782 B2 by Lute, Jr. et al. ("Lute") in view of Patent Number US 7,187,795 B2 by Jones et al ("Jones-2"). The banknote handling device disclosed by Jones comprises money-in module 14 that receives banknotes from a customer, a counterfeit collection box (see paragraph 0113, lines 7-11) that stores counterfeit banknotes and discrimination module 19 that carries out counterfeit detection and determines each banknote as counterfeit or as genuine. Said discrimination module further causes counterfeit banknotes to be stored in said counterfeit collection box (see paragraph 0113, lines 7-9). Jones further discloses a notification module that notifies the customer of predetermined kind of information indicative of a total amount of money received from the customer (see paragraph 0094, lines 1-12).

Jones further discloses multiple collection/storage boxes, including genuine banknote storage boxes, are stored in a safe (see Figure 2). The notification module information includes a number of each type of the banknotes received by the customer (see paragraph 0094, lines 5-10). Jones further discloses output module 136 that outputs a form describing the information (see paragraph 0094, lines 9-11), a setting module that specifies at least one of said multiple storage boxes to said counterfeit collection box (see paragraph 0106, lines 10-14, and paragraph 0108, lines 1-6) and database 33 that stores banknote type information corresponding to a number allocated to each of said multiple storage boxes. Still further Jones discloses temporary storage box (see paragraph 0118, lines 1-4) that temporarily keeps the banknotes received through said money-in module.

Jones fails to disclose the prohibition of the return of said counterfeit notes from said counterfeit collection box. Lute teaches a banknote handling device comprising counterfeit processing module 64 that stores banknotes determined to be counterfeit into counterfeit collection box 100, and prohibits said banknotes from being returned to a customer (see Figures 2, 3 and 6; column 9, lines 16-24; and column 11, lines 49-58) for the purpose of preventing counterfeit notes from being circulated. Lute further teaches said collection box being located outside of safe 48 which has multiple storage boxes 222-232. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the collection box/safe configuration of Lute into the device of Jones for the purpose of preventing counterfeit notes from being circulated.

Jones fails to disclose said information as being indicative of an amount of money settled as a transaction regardless of the result of said counterfeit detection, and fails to disclose said total amount of money as including an amount of money in counterfeit notes if existing in the banknotes received from the customer. Jones-2 teaches a banknote handling device comprising a notification module that notifies a customer of a total amount of money received from a customer as including an amount of money in counterfeit notes, and an amount of money settled as a transaction regardless of the result of said counterfeit detection (see column 26, line 61 through column 27, line 2) for the purpose of providing a customer with a complete accounting of a given transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the notification configuration of Jones-2 into the banknote handling device of Jones for the purpose of providing a customer with a complete accounting of a given transaction.

Claims 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Number 4,736,852 by Edin et al ("Edin") in view of Lute in view of Jones-2. The banknote handling device disclosed by Edin comprises money-in module 61 that receives a bundle of banknotes from a customer (see Figures 6a and 6b), a safe (see Figure 2) that stores said banknotes, multiple storage boxes 26 and 27 that are located in said safe and store banknotes classified by a banknote type, discrimination module that sets at least one of said boxes to a collection box to store counterfeit banknotes

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(see column 5, lines 18-48), and a control module 121, 122, 123 that sorts out each banknote determined to be counterfeit (see column 3, lines 3-26).

Edin fails to disclose the prohibition of the return of said counterfeit notes from said counterfeit collection box. Lute teaches a banknote handling device comprising counterfeit processing module 64 that stores banknotes determined to be counterfeit into counterfeit collection box 100, and prohibits said banknotes from being returned to a customer (see Figures 2, 3 and 6; column 9, lines 16-24; and column 11, lines 49-58) for the purpose of preventing counterfeit notes from being circulated. Lute further teaches said collection box being located outside of safe 48 which has multiple storage boxes 222-232. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the collection box/safe configuration of Lute into the device of Edin for the purpose of preventing counterfeit notes from being circulated.

Edin fails to disclose a customer information management module. Jones-2 teaches a banknote handling device comprising a management module that manages customer information that identifies each customer who handles a transaction and maps any counterfeit banknote involved in said transaction to said customer (see column 7, lines 3-59) for the purpose of tracking possible counterfeiters. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the customer information management configuration of Jones-2 into the banknote handling apparatus of Edin for the purpose of tracking possible counterfeiters.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over by Edin in view of Jones-2 in view of Patent Number US 6,749,053 B2 by Ikuta ("Ikuta"). The banknote handling device disclosed by Edin comprises money-in module 61 that receives a bundle of banknotes from a customer (see Figures 6a and 6b), a safe (see Figure 2) that stores said banknotes, discrimination module 121, 122, 123 that carries out counterfeit detection and determines each banknote as counterfeit or genuine (see column 3, lines 3-26), and collection box 26 that stores each banknote that is determined to be counterfeit and not to be returned to said customer (see column 5, lines 18-48).

Edin fails to disclose a customer information management module. Jones-2 teaches a banknote handling device comprising a management module that manages customer information that identifies each customer who handles a transaction and maps any counterfeit banknote involved in said transaction to said customer (see Abstract, lines 8-11; and column 7, lines 3-17) for the purpose of tracking possible counterfeiters. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the customer information management configuration of Jones-2 into the banknote handling apparatus of Edin for the purpose of tracking possible counterfeiters.

Edin fails to disclose said collection box being located outside of said safe. Ikuta teaches a banknote handling device comprising collection box 13 that is located outside of safe 1 (see Figure 2) for the purpose of selectively storing particular types of banknotes in a secure environment. It would have been obvious to one of ordinary skill

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in the art at the time the invention was made to incorporate the collection box/safe configuration of Ikuta into the banknote handling device of Edin for the purpose of selectively storing particular types of banknotes in a secure environment.

Response to Arguments

Applicant's arguments with respect to claims 1-14, 16, 17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb



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